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Application Serial No. 09/991,503  
Attorney Docket No. 08477.0099USC2  
Reply to Office Action of July 5, 2006**REMARKS**

The Non-Final Office Action (hereinafter the Action) mailed July 5, 2006 has been reviewed and these remarks are responsive thereto. Reconsideration of the present application is respectfully requested in view of these remarks. Prior to entry of this response, Claims 41-63 were pending in the application, of which Claims 41, 47, 53, 59, and 62 are independent. In the Office Action dated July 5, 2006, Claims 41-63 were rejected under 35 U.S.C. § 103(a). Following this response, Claims 41-63 remain in this application. Applicants hereby address the Examiner's rejections in turn.

***Claim Rejections Under 35 U.S.C. §103***

The Action rejected claims 41-53 and 55-63 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,331,546 to Webber, *et al.* (hereinafter Webber) in view of the article Which Frequent-Flier Program? (Airlines promise free travel, but their delivery record has been spotty. We identify the better programs.) Consumer Reports Travel Letter: vol. 6, no. 10, pp 112-116, October 1990. Dialog file 646; #00500249 (hereinafter Frequent-Flier Program), and further in view of U.S. Patent No. 5,855,369 to Lieberman (hereinafter Lieberman).

***Claim 41***

Claims 41 is rejected under 35 U.S.C. §103(a) as being unpatentable over Webber in view of Frequent-Flier Program and in further view of Lieberman. Specifically, regarding claim 41, the Action states:

As per claim 41, Webber teaches:

A computerized incentive system for awarding credits to persons who book travel-related reservations, the system comprising:

- (a) a computerized reservation system connected to a network;
- (b) an interface device connected to the network and configured so that a user of the interface device has access to the computerized reservation system (see column 4, lines 5-25);

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(c) a reservation facility computer system connected to the network and thereby accessible to the user accessing the computerized reservation system, the reservation facility computer system configured so that the user may book a travel related reservation (see column 6, line 65 - column 7, line 3; column 16, line 42 - column 17, line 5)

(d) a conversion system connected to the network, wherein the conversion system receives an availability format and then converts the travel-related reservation contained within the availability format into a standard format (see figure 1, item 26; see column 5, lines 35-45; figure 2, item 34; column 16, lines 41-60);

Webber fails to teach:

(e) an award system connected to the network, the award system being configured to receive data concerning the travel-related reservation, wherein the award system assigns credits to a person for whom the travel-related reservation has been booked upon verification that an event relating to the travel-related reservation has occurred. However, Lieberman teaches "purchase-required-for-entry" incentive programs where businesses that participates in said programs only give prizes or awards to customers that purchase and attend said participating businesses events. Which Frequent-Flier Program discloses about frequent-flier programs where people can earn credits in various ways, such as flying, staying at hotels, renting cars and use it for variety of awards (see paragraphs 5, 6, 9, 11, 17 and 47). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Webber's system would use the travelers' frequent flier numbers (see Webber column 17, lines 15-20; figure 86, item 326) to provide said travelers with offers or awards from different service providers which have frequent fliers programs, as taught by the Frequent-Flier program (see Frequent flier paragraph 54; "car rental", "Hotel"). The Webber's system would be motivated to link his system to the frequent flier programs of different service providers in order to allow frequent flier members to use the Webber's system to find not only an itinerary-with-fare combinations acceptable in terms of cost and convenience to said members but also the travel offers that let said members earn the most credits and/or awards in various way (i.e. such as flying, staying at hotels, renting cars, etc). It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that businesses that participate in a frequent flier program<sup>1</sup> would only give credit to customers that attend said businesses event, as taught by Lieberman in order that said businesses don't finish paying money as credit to customers that never attended said events. It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the purpose of providing an incentive program (i.e. frequent flier program) is to give

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<sup>1</sup> Frequent Flier paragraph 18

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customers an added incentive to attend said businesses' events, as taught by Lieberman but business would not be that willing to participate in said incentive programs, if said participating businesses have to give credits or prizes to customers that never attended said businesses events. Therefore, eliminating the purpose of providing said incentive programs to said customers, which is to increase profits to said businesses due to the increase attendance.

Applicant respectfully traverses the Action's rejection. Courts have generally recognized that a showing of a *prima facie* case of obviousness necessitates three requirements: (i) some suggestion or motivation, whether in the references themselves or in the knowledge of a person of ordinary skill in the art to modify the reference or combine the reference teachings; (ii) a reasonable expectation of success; and (iii) the prior art references must teach or suggest all claim limitations. MPEP §2143; *In re Dembiczak*, 175 F.3d 994 (Fed. Cir 1999); *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998); *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573 (Fed. Cir. 1996).

The references used in the Action fails at least the third prong of obviousness. Claim 41 is patentably distinguishable over the cited art for at least the reason that it recites, *inter alia*, an award system connected to the network, the award system being configured to receive data concerning the travel-related reservation, wherein the award system assigns credits to a person for whom the travel-related reservation has been booked upon verification that an event relating to the travel-related reservation has occurred.

In contrast, per Action's admission:

Webber fails to teach:

(e) an award system connected to the network, the award system being configured to receive data concerning the travel-related reservation, wherein the award system assigns credits to a person for whom the travel-related reservation has been booked upon verification that an event relating to the travel-related reservation has occurred." See Action page 3, lines 16-21.

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In an attempt to overcome Webber's deficiencies, the Action relies on Lieberman. Lieberman relates to "methods and equipment specifically adapted to those prize drawing games of chance aimed at promoting a particular product or item of merchandise. . .", see Liebman column 1 lines 15-17. Liebman discloses the use of bar codes and UPCs as aids in the operation and administration of a product-promotional prize drawing game of chance. The Examiner references Liebman for the proposition that

It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that businesses that participate in a frequent flier program<sup>2</sup> would only give credit to customers that attend said businesses event, as taught by Lieberman in order that said businesses don't finish paying money as credit to customers that never attended said events.

See Office Action Page 9. Applicant respectfully submits that Liebman does not teach that businesses that participate in a frequent flier program would only give credit to customers that attend said businesses event. Applicant has identified in the background of Liebman a discussion of "Purchase required for entry" games, such as prize drawings. Liebman states, "prize drawings typically require the entrant to purchase, directly or indirectly, a chance to win the offered prize. For example, theaters use patrons' numbered ticket stubs as entry forms in prize drawings; but the theater patron is required, at least indirectly and incidentally, to pay money for a chance to win the drawing, since the patron has an opportunity to participate in such a drawing only because he has purchased a theater ticket bearing a numbered stub." Column 1 lines 16-24. Liebman further states that:

[p]urchase-required-for-entry" games of chance can be difficult to administer because they are legally problematical in some jurisdictions, where anti-lottery laws prohibit or heavily regulate prize drawing games of chance in which something must be purchased, or in which something of value must otherwise be given by the entrant, in order to have a chance at winning the prize. Hence, the administration of a "purchase-required-for-entry" game of chance may be cumbersome, expensive or even impractical altogether, especially on an interstate scale, due to difficulties in compliance with local variations in the law. Typically, however, legal objections to a prize drawing game of chance may be overcome by providing means to enter the drawing which do not require the entrant,

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<sup>2</sup> Frequent Flier paragraph 18

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directly or indirectly, to make a purchase or otherwise part with anything of value in return for a chance at winning the prize.

See Column 1 line 64 - Column 2 line 12 Accordingly, while Liebman identifies purchase required for entry games, such as prize drawings, these games were identified to set up the discussion of methods of entering prize drawings that "do not require the entrant, directly or indirectly, to make a purchase." The invention disclosed in Liebman does not require the entrant to make a purchase. Moreover, the purchase required for entry games, such as prize drawings, discussed in the background of Liebman, when combined with Webber do not result in the system claimed. Applicant respectfully disagrees that combining Webber with the statements concerning "purchase required for entry prize drawings" disclosed in the background of Liebman result in the present invention.

In addition, Frequent-Flier Program does not overcome Webber's and Lieberman's deficiencies. Frequent-Flier Program merely discloses a comparison of 12 programs as currently operated by 13 major US airlines and how well Consumer Report Travel Letter readers think these programs deliver on their promises, based on data from Consumer Report Travel Letter own survey. (Frequent-Flier Program paragraph 2). Like Webber, Frequent-Flier Program at least does not teach or suggest the verification that an event relating to the travel-related reservation has occurred.

Combining Webber with Frequent-Flier Program would not have led to the claimed invention because Webber and Frequent-Flier Program, either individually or in combination, at least do not disclose or suggest the verification that an event relating to the travel-related reservation has occurred, as recited by Claim 41. Accordingly, independent Claim 41 patentably distinguishes the present invention over the cited art, and Applicants respectfully request withdrawal of this rejection of Claim 41.

Furthermore, the references cited in the Action fail the first prong of obviousness in that there is no suggestion or motivation, whether in the references themselves or in the knowledge of

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